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REMARKS/ARUGMENTS

This is in response to the Office Action dated May 4, 2006. Claims 1 and 2 have been amended. No new matter has been added. Claims 1-6 remain pending in this application with claim 1 being the only independent claim. Reconsideration in view of the amendments and remarks presented herein is respectfully requested.

On a preliminary note, the Examiner did not consider JP 3024357 cited in the Information Disclosure Statement filed on April 5, 2005 on the basis that no translation of the foreign reference was provided. Applicants submit that on page 2 of the Information Disclosure Statement filed with the PTO Form SB/08 it was specifically pointed out to the Examiner that this reference was identified in the International Search Report (a copy of which was submitted simultaneously with the Information Disclosure Statement on April 5, 2005). Pursuant to MPEP §609.04(a) "Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report." Therefore, Applicants maintain that the International Search Report provided with the Information Disclosure Statement satisfies the requirement for a concise explanation of the relevancy of this non-English reference. The Examiner is thus requested to consider this reference and provide an initialed copy of the PTO Form SB/08 in the next communication.

In the outstanding Office Action, the Examiner has objected to the Abstract as failing to conform to proper language and format. Applicants respectfully traverse the Examiner's objection. The Preliminary Amendment filed on April 5, 2005 sets for the amended Abstract on a separate page as a single paragraph limited to under 150 words in length. Furthermore, no legal phraseology is employed and the paragraph sufficiently describes the disclosure. Accordingly, it is unclear why the Examiner has objected to the Abstract and if the objection is not withdrawn, Applicants request further clarification as to the specific grounds for the objection.

Claim 1 is objected to on formal grounds due to a typographical error found in line 20. Applicants have amended claim 1 to correct for this typographical error and thus request that this

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objection be withdrawn.

Claims 1-4 and 6 are rejected under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 5,858,012 (Yamaki et al.) in view of U.S. Patent No. 6,369,291 (Uchimoto et al.). Claim 5 is rejected under 35 U.S.C. §103(a) as obvious over Yamaki et al. and Uchimoto et al. in view of JP 09-271488 (Iwao et al.).

Applicants respectfully traverse the prior art rejection of claims 1-6 for the reasons discussed below.

Independent Claim 1

In the outstanding Office Action the Examiner acknowledges that Yamaki et al. fails to disclose or suggest the following two limitations (i) "a greater number of rear waist elastic members are provided than front waist elastic members"; and (ii) "said rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body". The Examiner, however, asserts that Uchimoto et al. in combination with Yamaki et al. teaches these missing limitations.

> "Uchimoto et al, at column 7, lines 5-17 teaches the ability of the stretching force, i.e., the elastic, to be changed between the rear and front waist area to accommodate wearers' having large-sized buttocks with lesser stretching force, i.e. lesser number of rear elastic members, such that the buttocks are not forcibly tightened, and for smaller-sized buttocks a greater stretching force, i.e. greater number of rear elastic members thereby to prevent gapping and leakage, and equal stretching force, i.e. equal number of elastic members, for lean wearers having small buttocks, thus disclosing the desired to have greater or lesser stretching force, i.e. greater or lesser number of elastic members, in the rear elastic area depending on the larger or smaller size of the wearers' buttocks." (May 4, 2006 Office Action; page 4, lines 11-19)

Applicants respectfully traverse the Examiner's interpretation of the teachings of Uchimoto et al. MPEP §2131.02 provides that "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed limitation. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." Uchimoto et al. discloses (Col. 3, ll. 45-50) "Between the waist elastic member 53 and the leg elastic members 54, a plurality of thread-like elastic materials are provided as a fitting elastic member 55 in parallel to the waist elastic members 53 over the entire circumference of the disposable underpants 1." (emphasis added) Thus, since the

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fitting elastic member 55 is disposed over the entire circumference of the disposable underpants 1, the reference expressly teaches an equal number of rear waist elastic members and front waist elastic members. In further support thereof, an equal number of front and rear elastic members 55 are shown in Figure 2.

Addressing the second limitation in claim 1 in which "said rear elastic area is broader than said front elastic area with respect to the longitudinal direction of said absorbent article body", Applicants assert that this limitation is also not disclosed in the prior art of record. Since claim 1 expressly provides that the "rear waist elastic members form a rear elastic area in said rear waist region" and the "front waist elastic members form a front elastic area in said front waist region" and Uchimoto et al. has an equal number of rear and front waist elastic members then the rear and elastic areas in Uchimoto et al. must also equal. This is in direct contrast to the express claimed invention.

Applicants disagree with the Examiner's remarks that Uchimoto et al. teaches this limitation of claim 1. In the outstanding Office Action the Examiner states:

> "Independent of whether the fitting elastic member overlaps the absorbent core or not, its stretching force may be changed between the front and rear sides of the disposable underpants. In the case of large-size disposable underpants frequently used by people having large buttocks, sealability can be ensured even if the stretching force of the rear side is made weaker than that of the front side, so that the buttocks are not forcibly tightened. Further, since most of the lean people have small buttocks, it is preferable to substantially equally set the stretching forces of the front and rear sides in small-size disposable underpants. Furthermore, the fitting elastic member may be provided in different positions (upper and lower portions) at the front and rear sides of the disposable underpants." (Col. 7, ll. 4-17)

The passage quoted above from Uchimoto et al. describes only the stretching forces of the front and rear side, but does not expressly teach increasing the number of rear versus front elastic members. Nevertheless, the Examiner infers from the text that increasing or decreasing the number of front versus rear elastic members will have an impact on the stretching forces. However, the reference when read as a whole teaches away from such interpretation or inference since the fitting elastic members 55 extend over the entire circumference of the disposable underpants 1 (Col. 3, ll. 45-50). Accordingly, applicants submit that claim 1 is patentable over the prior art of record.

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Dependent Claim 2

Claim 2, as amended, now states "both ends of some but less than all of said rear waist elastic members are respectively connected to the ends of the corresponding front waist elastic members" (emphasis added). To the contrary, Yamaki et al. discloses (Figure 1) all of the waist elastic members 23 in the rear waist region 7 are respectively connected to the ends of the corresponding waist elastic members 23 in the front waist region 6, rather than less than all, as found in claim 2.

Dependent Claim 3

Claim 3 provides "the distance between said waist opening elastic members and the portion of said rear waist elastic members closest to said waist opening elastic members is approximately equal to said distance between each rear waist elastic member and its adjacent rear waist elastic member". In rejecting claim 3, the Examiner states " With respect to claim 3, as seen in Figure 2, Yamaki et al. disclose the distance between the waist opening elastic members (21) and the portion of the rear waist elastic members (23) is approximately equal to the distance between each rear waist elastic member (23) and is adjacent rear waist elastic member (23)." (May 4, 2006 Office Action; p. 5, ll. 5-8)

Applicants respectfully traverse the Examiner's rejection. Figure 2 of Yamaki et al. is merely a plan view of the diaper unfolded back and forth from its state shown in Figure 1. In Figure 1, the distance between the elastic member 21 and the portion of the elastic members 23 in the rear region 7 is greater (approximately 2 times greater) than the distance between each elastic member 23 and its adjacent elastic member 23 in the rear waist region 7. Applicants submit that the Examiner has improperly relied on the scale of the drawings alone, absent any disclosure in the specification, to teach this claimed limitation. MPEP §2125 provides "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. '[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.')".

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Yamaki et al. fails to indicate that the drawings are drawn to scale. Accordingly, any measurements based on the drawings alone, especially in light of the inconsistency in the scale of related figures in the drawings, is not a proper basis for rejecting the claimed invention.

Dependent Claim 4

Claim 4 states that the "absorbent core is arranged so as not to overlap said front elastic area while overlapping at least a part of said rear elastic area". In the outstanding Office Action the Examiner asserts that in Yamaki et al. "the absorbent core (38) is arranged so as not to overlap the front waist elastic area (26) while not overlapping at least a part of the rear elastic area (26) (col. 2, ll. 35-65; col. 1, ll. 40-51; abstract, penultimate lines)." (May 4, 2005 Office Action; p. 5, ll. 13-15) Applicants respectfully disagree with the Examiner's interpretation of the claimed front elastic area reading on front end (26) in Figure 2 of Yamaki et al. Claim 1, from which claim 4 depends, expressly states "said rear waist elastic members form a rear elastic area in said rear waist region" while "said front waist elastic members form a front elastic area in said front waist region". Clearly, in Figure 2 of Yamaki et al. the absorbent 2 including absorbent core 38 overlaps front elastic members 23 which define the front elastic area (as called for in claim 1). Accordingly, Yamaki et al. fails to disclose or suggest that the absorbent core is arranged so as not to overlap the front elastic area, as found in claim 4.

Dependent Claim 5

Claim 5 states "the portion of said front waist elastic members closest to said leg opening portions is located closer to said leg opening portions than is the portion of said rear waist elastic members closest to said leg opening portions". The Examiner refers to Figure 5 of Iwao (JP 09-271488) as teaching this feature of the claimed invention. Applicants have reviewed Figure 5 and submit that the drawing depicts the portion of the front waist elastic members closest to the leg opening portions located the same distance to the leg opening portions as the portion of the rear waist elastic members closest to the leg opening portions. Even assuming, *arguendo*, that the two distances are not exactly equal then once again pursuant to MPEP § 2125 Applicants submit that it is improper for the Examiner to rely on measurements from the drawings alone of a prior art reference when the disclosure does not expressly state that the drawings are drawn to scale.

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In addition, claim 5 also provides "said absorbent core is arranged so as not to overlap said rear elastic area while overlapping at least a part of said front elastic area". This limitation is similar to that found in dependent claim 6. In the outstanding Office Action the Examiner asserts that Yamaki et al. teaches this limitation for the reasons set forth with respect to claim 6. Applicants respectfully maintain that this limitation of claim 5 is distinguishable over the art of record for the same reasons provided below with respect to claim 6.

Applicants next address the Examiner's remarks in the outstanding Office Action rejecting claim 5 as obvious in view of the prior art of record.

> "The specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising from therefrom, and that as such the limitation were arbitrary and therefore obvious. Such unsupported limitations cannot be the basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine the ideal waist elastic configuration for a particular article." (May 4, 2005 Office Action; p. 6, ll. 15-21)

Applicants assert that the Examiner's reliance on the case *In re Woodruff* in this present limitation is misplaced. The case concerns when the claimed ranges overlap or lie inside ranges disclosed in the prior art. Here there are no ranges, nor has the prior art reference even recognized the parameter. Pursuant to MPEP §2144.05 (II)(B) "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. None of the prior art references recognize varying the positioning of the portion of the front waist elastic members and rear waist elastic members relative to their respective leg opening portions. Accordingly, this parameter is not recognized in the art to be a result-effective variable and it is therefore improper for the Examiner to require Applicants to establish the critical nature of the claim limitations.

Dependent Claim 6

Claim 6 states "said absorbent core is arranged so as not to overlap said rear elastic area while overlapping at least a part of said front elastic area". In the outstanding Office Action the Examiner asserts that in Yamaki et al. "the absorbent core (38) is arranged so as not to overlap

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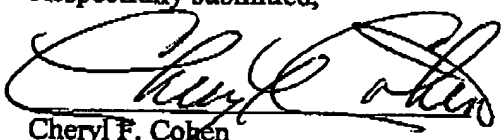
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the rear elastic area (26) while overlapping at least a part of the front elastic area (27)." (May 4, 2006 Office Action; page 5, ll. 20-21) Applicants respectfully traverse the Examiner's interpretation of the claimed rear elastic area reading on front end (26) in Figure 2 of Yamaki et al. Claim 1, from which claim 6 depends, expressly states "said rear waist elastic members form a rear elastic area in said rear waist region" while "said front waist elastic members form a front elastic area in said front waist region". Clearly, in Figure 2 of Yamaki et al. the absorbent 2 including absorbent core 38 overlaps rear elastic members 23 which define the rear elastic area (as called for in claim 1) and extends all the way to the upper end 27 of the rear waist region 7. Accordingly, Yamaki et al. fails to disclose or suggest that the absorbent core is arranged so as not to overlap the rear elastic area, as found in claim 6.

For the foregoing reasons Applicants submit that independent claims 1-6 are patentable over the art of record. Applicants submit that the application is now in condition for allowance and passage to issuance is requested.

If any additional fees or charges are required at this time in connection with the application, authorization is hereby given to charge our Patent and Trademark Office Deposit Account No. 503462.

Respectfully submitted,



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